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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ryszard Sprycha

C-411

7480

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EXAMINER

LIPMAN, BERNARD

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	09/982,496		SPRYCHA ET AL.	
	Examiner		Art Unit	
	Callie E. Shosho		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3-15, and 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catena et al. (U.S. 5,338,785) in view of EP 621319 and Kuder et al. (U.S. 6,013,373).

The rejection is adequately set forth in paragraph 7 of the office action mailed 7/7/06 and is incorporated here by reference.

Response to Arguments

3. Applicants' arguments filed 7/6/07 have been fully considered but they are not persuasive.

Specifically, applicants argue that there is no motivation to combine Catena et al. with EP 621319 given that EP 621319 does not disclose pigments other than phthalocyanine and does not disclose laminating inks.

However, while it is agreed that EP 621319 is drawn to composition comprising phthalocyanine pigment, it is noted that example 7 of Catena et al. referred to by the examiner in the rejection of record, also discloses ink comprising phthalocyanine pigment. Further, it is noted that present claims 1 and 15 broadly require the use of pigment which clearly encompasses all

types of pigment including phthalocyanine while present claims 3, 17, and 30 specifically disclose the use of phthalocyanine pigment.

Further, while EP 621319 is drawn to inks, it is agreed that there is no disclosure in EP 621319 of laminating inks.

However, applicants' are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." EP 621319 is, therefore, a reasonably pertinent reference, because it teaches that the use of potassium hydroxide, lithium hydroxide, or sodium hydroxide in ink comprising phthalocyanine produces ink with excellent fluidity and stability with time as compared to ink comprising phthalocyanine alone which is a function especially pertinent to the invention at hand as well as Catena et al.

Applicants argue that one would not combine a reference directed to laminating inks with a reference directed to other types of inks given that laminating inks, as disclosed by col.1, lines 26-35 of Catena et al., are a specialized type of ink with specialized requirements.

However, while col.1, lines 26-33 of Catena et al. do disclose that the inks must be carefully formulated so as to avoid problems, there is nothing in Catena et al. that excludes the use of potassium hydroxide, lithium hydroxide, or sodium hydroxide as disclosed by EP 621319. Further, given that EP 621319 discloses that the use of potassium hydroxide, lithium hydroxide,

or sodium hydroxide in ink comprising phthalocyanine produces ink with excellent fluidity and stability with time as compared to ink comprising phthalocyanine alone and given that Catena et al. disclose ink comprising phthalocyanine, it is the examiner's position, absent evidence to the contrary, that it would have been obvious to one of ordinary skill in the art to utilize the potassium hydroxide, lithium hydroxide, or sodium hydroxide in the ink of Catena et al. in order to produce ink with excellent fluidity and stability with time. Based on the teachings of EP 621319, one of ordinary skill in the art would have recognized that potassium hydroxide, lithium hydroxide, or sodium hydroxide function so as to improve fluidity and stability in ink comprising phthalocyanine and would have expected such potassium hydroxide, lithium hydroxide, or sodium hydroxide to function as such in other inks.

Applicants argue that one of ordinary skill in the art would not add a water-soluble component to a non-aqueous ink absent a specific teaching that such an addition would function in the particular ink because of the general understanding that poor results are usually obtained by such an addition.

However, given that EP 621319 discloses using potassium hydroxide, lithium hydroxide, or sodium hydroxide with phthalocyanine in non-aqueous ink, it is the examiner's position that one of ordinary skill in the art would add the water-soluble component, i.e. potassium hydroxide, lithium hydroxide, or sodium hydroxide, of EP 621319 to the non-aqueous ink of Catena et al. That is, given that the water-soluble component functions in the non-aqueous ink of EP 621319 without poor results, it would have been obvious to one of ordinary skill in the art to utilize such water-soluble component in the non-aqueous ink of Catena et al. and also not expect poor results.

Applicants argue that since there is no disclosure of organic base, aminoalcohol, and organic or inorganic acid in Catena et al. or EP 621319, claims 9-14 should not be rejected.

However, each of claims 9-14, which recite specific organic base, aminoalcohol, and acids, depends on claim 1 which requires viscosity stabilizing, resolubility promoting, water-soluble compound selected from the group consisting of base, aminoalcohol, acid, and aminoacid. Each of claims 9-14 do not require that the ink actually comprise the organic base or aminoalcohol or acid, only that the water-soluble compound is selected from the group consisting of base, aminoalcohol, acid, and aminoacid wherein claims 9-14 disclose specific types of organic base, aminoalcohol, and acids. Given that claims 9-14 only further specify the members of the Markush group with respect to the water-soluble compound, it is the examiner's position that they are properly rejected by the prior art of record.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho
Primary Examiner
Art Unit 1714